

REMARKS

The present amendment is in response to the Advisory Office Action dated August 8, 2007, where the Examiner indicated that the prior filed amendments would not be entered because they raise new issues requiring further search and consideration. In the present amendment, claims 41, 46, and 49 have been amended. Accordingly, claims 41 – 54 are pending in the present application with claims 41, 46, and 49 being the independent claims. Reconsideration and allowance of pending claims 41 – 54 in view of the amendments and the following remarks are respectfully requested.

A. Claim Rejections under 35 U.S.C. § 103(a)

(1) Schmidt (U.S. Patent No. 6,208,872) and in view of Irvin (U.S. Patent No. 6,556,819)

In the May 8, 2007 Final Office Action ("Office Action") claims 41-54 were rejected as being unpatentable over Schmidt (United States Patent No. 6,208,872) in view of Irvin (United States Patent No. 6,556,819). In light of the arguments contained herein, the Applicants respectfully request that this rejection be withdrawn.

With regard to independent claims 41, 46, and 49 the Office Action states that Schmidt teaches all of the elements of the claims, except utilizing a GPS functional device contained within the wireless communication device. The Office Action further states that Irvin teaches this limitation. The Office Action states that the combination of Schmidt and Irvin makes the claims obvious. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the cited references would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the cited reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion

to make the claimed combination and the reasonable expectation of success must both be found in the cited references, and not based on Applicant's disclosure.

1. Suggestion or Motivation to Combine

The subject matter of the claims is restricting communications between wireless communication devices. The Schmidt reference addresses checking to ensure that placing and receiving calls is allowed during roaming, before a call is placed by or received by a potentially roaming wireless communication device. The Irvin reference is directed to utilizing a position sensing system to determine when a device is in a safe zone. (See, Irvin, Abstract).

There are very significant differences between independent claims 41, 46, and 49 and Schmidt's handling of communications while a device is potentially roaming. There are also significant differences between Irvin's utilizing GPS to determine whether a device is in a safe zone. Namely, neither cited reference taken alone or in combination suggests an implementation of restricting communications between wireless communication devices as is presently claimed, irrespective of the physical location of the devices.

For example, whenever a wireless communication device (i.e., mobile station) in Schmidt places an outgoing call or receives an incoming call, a determinator component first checks to see if the mobile station is roaming by checking to see "if the system ID number of the cellular network in which the mobile station is currently located (the "current system ID number"), matches the system ID number of the mobile station's home system (the "home system ID number", which is conventionally stored in the mobile station" and then if the wireless communication device is determined to be roaming, allowing the outgoing call to be placed or incoming call to be received only if the "ROEF-2 is in a state "1" permitting calls" to be placed or received while roaming. (See Schmidt, Column 6, lines 15-16, 27-38; Column 7, line 58 – Column 8, lines 44-59). Thus Schmidt discloses allowing or denying of communications when roaming or not roaming.

A combination of Irvin's location identifying system with Schmidt results in using GPS instead of the ROEF state to determine whether the device is roaming (i.e., away

from its base station geographically). However, such a combination restricts calls in a manner that is completely dependent on the physical location of the device.

There is no suggestion or motivation from Schmidt or Irvin to utilize a controller to determine "a parameter associated with the geographic characteristic stored in the memory indicates that the geographic characteristic is an approved geographic characteristic, the parameter being independent of the physical location of the wireless communication device." (See claim 41, for example. Similar language is found in independent claims 46 and 49).

The cited references do not suggest this limitation. Schmidt discloses setting the ROEF state to roaming or not roaming based upon the physical location of the mobile device. THE ROEF state indicates that the call is allowed (e.g., not roaming) or the call is not allowed (e.g., roaming). Thus, Schmidt's parameter (i.e., state) is not independent of the physical location of the device, because the ROEF state is location dependent. Moreover, use of the ROEF state suggest to someone having skill in the art that location dependent information should be stored in memory. The present claims are directed to a parameter that is location independent.

The addition of Irvin does not remedy the failings of Schmidt. Irvin discloses using GPS to determine the location of the device. Thus, any parameter based on Irvin's disclosure (i.e., GPS location) is also not independent of the physical location of the device as required by the independent claims. Accordingly, the references do not disclose every element of the independent claims either alone or in combination and applicant believes that the claims are all presently in condition for allowance.

2. Reasonable Expectation of Success

Further, the Office Action has not demonstrated that the combination of the cited references points to the reasonable expectation of success in the present claims, which is the second requirement of the obviousness analysis.

For example, Schmitt does not describe that a "location independent" parameter associated with the geographic characteristic is stored in the memory and "indicates that the geographic characteristic is an approved geographic characteristic." (See claims 41, 46, and 49, although the wording varies slightly between each of these claims). Similarly, Irvin only deals with using location sensing systems to determine

whether a device is in a safe zone. Even if Schmidt is combined with Irvin, there is no expectation that the combination would result in a location independent parameter because neither reference contemplates such a parameter. Schmidt and Irvin each disclose parameters that the dependent upon the location of the device.

Accordingly, based on the teachings of Irvin and Schmidt, the combination lacks a location independent parameter in memory associated with a geographic characteristic to indicate whether the characteristic is approved. The parameter in Schmidt (ROEF state) is related to the location of the device and the parameter in Irvin (GPS location) is also related to the location of the device. In contrast, the parameter in independent claims 41, 46, and 49 is independent of the physical location of the device.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. For example, the present independent claims 41, 46, and 49 include the limitations of “utilizing a controller to determine if a parameter associated with the geographic characteristic stored in the memory indicates that the geographic characteristic is an approved geographic characteristic, the parameter being independent of the physical location of the wireless communication device,” (claim 41), “a memory for storing at least one area code, a location independent parameter associated with the at least one area code, and at least one authorized location,” (claim 46), and a memory for storing a geographic characteristic, a parameter associated with the geographic characteristic, and an authorized location, “wherein the parameter is not dependent on the current physical location” of the device. (claim 49).

Schmidt and Irvin do not teach, suggest, or describe these limitations. Irvin is cited for teaching determining a physical location of a device. Schmidt associates a state machine with a physical location of a device to restrict calls while roaming. Thus, even if the state machine tracks the ROEF state as a parameter, the ROEF state is not associated with a geographic characteristic or area code stored in memory and the ROEF state is not a location independent parameter. Instead, it is associated with the physical location of a device. Similarly, Irvin discloses determining the physical location

of the device, e.g., by using GPS. However the GPS location parameter of Irvin is also not a location independent parameter.

Since the combination of references does not include all of the limitations of independent claims 41, 46, and 49, Applicant requests that the rejection be withdrawn and a notice of allowance be issued for claims 41-54.

4. Effect of KSR

After the recent Supreme Court decision in the KSR case, although it is clear that the above analysis using the Federal Circuit's teaching-suggestion-motivation test is not the only way to approach the obviousness inquiry, it remains a useful tool in the obviousness inquiry. However, even if an alternative tool is employed as part of the obviousness inquiry, it is clear from KSR that any combination of references in an obviousness rejection must provide reasonable inferences that are based on substantial evidence in the record. Here, no such substantial evidence has been identified and therefore even after KSR, Applicant asserts that the pending claims are not obvious in view of the prior art of record.

(2) Schmidt (U.S. Patent No. 6,208,872) and in view of Agness et al. (U.S. Patent No. 6,799,052)

The Office Action additionally rejects claims 41, 46, and 49 as being unpatentable over Schmidt in view of Agness et al. (United States Patent No. 6,799,052). In light of the arguments contained herein, the Applicants respectfully request that this rejection be withdrawn.

With regard to independent claim 41, 46, and 49 the Office Action states that Schmidt teaches all of the elements of the claims, except utilizing a GPS functional device. The Office Action further states that Agness teaches this limitation. The Office Action states that the combination of Schmidt and Agness makes the claims obvious. This rejection is also traversed based on the analysis set forth above.

As previously described, Schmidt does not disclose a parameter associated with a geographic characteristic where the parameter is independent of the physical location of the device. Agness does not cure the deficiencies of Schmidt because the parameter (e.g., GPS location) disclosed by Agness is completely dependent on the location of the device. Accordingly, just as with the previous combination of Schmidt and Irvin, the combination of Schmidt and Agness fails to provide a reasonable expectation of success in arriving at the present claims and further fails to disclose each and every element of the claims. Since the combination of references does not include all the limitations of claims 41, 46, and 49, the Applicant requests that the rejection be withdrawn and a notice of allowance be issued for all pending claims 41-54.

B. Conclusion

For all the foregoing reasons, allowance of claims 41-54 pending in the present application is respectfully requested. If necessary, applicant requests, under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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